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during the interview, as set forth above, and since the requirement was made in error, no formal drawings are submitted herewith.

Claim Rejections Under 35 U.S.C. § 103(a)

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1. Final Rejection is Premature

Paragraph 6 of the Office Action states that claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Syed in view of Jewell. This is a new rejection of claim 1 that was not made in the previous May 30, 2002 Office Action. Additionally, no substantive changes were made to claim 1 and no Information Disclosure Statements were filed after the mailing date of the first Office Action. Accordingly, claim 1 is subject to a new rejection that was not necessitated by amendment and not based upon art cited by the Applicant after the May 30, 2002 Office Action. Thus, the Final Rejection is improper. MPEP 706.07(a).

Accordingly, Applicants respectfully request that the Final Rejection be withdrawn.

2. Claims 1-23

In paragraphs 3 and 5 of the Office Action, claims 1, 2, 5-9 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beringer in view of Jewell. This rejection is respectfully traversed since the two references are not properly combinable and since even if properly combinable, the resulting structure does not satisfy the claim limitations.

With respect to claims 1 and 13, the Office Action states that Beringer "does not disclose an elongated first scale made of metal and having a lower surface, said lower surface being rigidly and unreleasably attached to said first scale-supporting section." The Office Action then discusses Jewell and states that "it would have been obvious...to further modify...Beringer, so as to include a contact surface having a second indicia." However, there is no motivation or explanation as to how Beringer is modified to provide for the admitted shortcomings of Beringer, that is, a first scale having a lower surface, the lower surface being rigidly and unreleasably attached to the first scale-supporting section. The Office Action instead, merely address other missing elements from other claims without addressing how a scale of Jewell can be attached to a scale supporting section and to Beringer.

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In fact, Jewell merely discloses four flat, metal pieces that are attached at their respective ends along diagonals as illustrated in Fig. 1. The lower surfaces of these metal pieces are not attached to any scale supporting section. Also, Bearinger discloses a plastic paper holder having no scales with lower surfaces that are attached to scale supporting sections. Thus, neither of the references disclose or suggest any kind of scale having a lower surface rigidly and unreleasably attached to a scale supporting section, as claimed.

Since the Office Action fails to explain how Bearinger is modified in view of Jewell to satisfy the stated missing element of Bearinger, and since there is no way to modify Bearinger in view of Jewell to satisfy the claim limitations, the rejection is deficient and improper.

In paragraph 8, the Office Action states that "'unreleasably attached' is sufficiently broad enough to embrace constructions united by such means as fastening and welding." However, the Office Action does not address the manner in which a first scale made of metal would be unreleasably attached, as claimed, to the holder of Bearinger. Additionally, since Bearinger is formed of plastic and Jewell is formed of metal, it is not evident how metal and plastic would be welded together or that such a suggestion to do so exists in the references.

In paragraph 11, the Office Action states that "one could still utilize the paper holder of Bearinger and its intended uses even with a scale on the lower surface." This is inaccurate. If the paper holder of Bearinger is up-side-down, to use a scale on its lower surface, the paper holder slot 30 is blocked and no paper can be inserted into the slot and held. Additionally, there is no motivation to modify Bearinger to block slot 30 and thereby prohibit use of the main, paper-holding feature of the Bearinger patent, as proposed by the Office Action.

In paragraph 12 of the Office Action, with respect to claim 14, the term "substantially parallel" is deemed "a broad term which may read upon Bearinger's disclosure of 'the upper surfaces which are inclined slightly.'" This interpretation of the term "substantially parallel" is respectfully traversed. The Federal Circuit recently addressed the term "substantially" and stated that the question is how the phrase would be understood by persons experienced in the field upon reading the application documents. *See, Verve LLC v. Crane Cams, Inc. et al.*, 65 USPQ2d 1051 (Fed. Cir. 2002). Applicants contend that a person experienced in the field

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would not interpret the term "substantially parallel" to encompass surfaces explicitly described as being "inclined," as in Bearinger.

In paragraph 14, the Office Action states that limitations from the specification are not read into claim 20, which contains a means-plus-function limitation under 35 USC §112, 6th paragraph. However, this statement in paragraph 14 appears to directly conflict with 35 USC §112, 6th paragraph, which states that a means-plus-function limitation "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Thus, elements of the specification must be read into a means-plus-function limitation to interpret the limitation.

The Office Action has not provided a proper analysis of claim 20, which contains a means-plus-function limitation. In paragraph 13, the Office Action appears to take the position that the paper retainer 22 of Bearinger is equivalent to the upstanding section 24 of the application and the plurality of ribs 39 attached thereto. However, this is not stated in the Office Action. Further, even if it was stated, this is not a sufficient prima facie case of equivalence as set forth in MPEP 2183, which, in part, states that "the Examiner should provide an explanation and rationale in the Office Action as to why the prior art element is an equivalent." The Office Action provides no explanation or rationale, especially with respect to the various factors set forth in MPEP 2183. Thus, the rejection to claim 20 is improper.

In paragraph 4, claims 3, 4, 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bearinger in view of Jewell and further in view of Syed (GB 2180799A). The Office Action attempts to provide the ribs of Syed to the paper retainer 22 of Bearinger. However, no explanation is given as to how a rib of Syed could be provided on the paper retainer 22 of Bearinger. The ribs of Syed are located on a roller 56 that rotates around an axis to move the ruler. Thus, to provide the ribs of Syed to Bearinger, the roller 56 of Syed must also be provided to Bearinger, for there would be no motivation to do otherwise. However, even if it is assumed that there is motivation to provide the roller 56 of Syed to Bearinger, the combination would result in the replacement of the paper retainer 22 of Bearinger with the roller 56 of Syed. Yet such a combination would destroy the paper holding capabilities of Bearinger and, thus, is an improper modification of Bearinger.

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In paragraph 6 of the Office Action, claims 1 and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Syed in view of Jewell. This rejection is respectfully traversed for the reasons set forth above with respect to claims 1 and 13 as there is no motivation to provide a scale as disclosed in Jewell on a ruler as disclosed in Syed. Neither of the references disclose or suggest a scale having a lower surface that is rigidly and unreleasably attached to a scale supporting section, as claimed.

In view of the foregoing, withdrawal of the objection and rejections is respectfully requested. Also, the claims are believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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